UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on June 5, 2000 corresponding to the U.S. Application No. 08/352,883, which had been Patented (U.S. Pat. 6301016), has been being considered by the examiner.

Claim Objections

1.   Claim 30 is objected to because of the following informalities: Claim 30, p. 48, line 7 "job designation means" should read as "job designation process". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25 & 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitations recited in claims 25 & 29 are unclear to the examiner ("controlling drawing means of an Operating System to execute the acquired EMF file"); therefore, the limitations as recited are vague and indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.   Claims 1, 3-4, 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurachi (U.S. Pat. 6181436).

2.   Regarding claims 1 & 4 , Kurachi discloses a server apparatus (print server apparatus, col. 11, line 67, Fig. 6, ref #8) capable of communicating with at least one client and a printer via a network (Fig. 1, col. 1, lines 5-9), comprising:

(1) image storage means for storing print data (Print Data Storing Device, Fig. 3, col. 2, lines 10-50) of a print job to be executed by a print request from said client;

(2) order management means for managing a print order of the print job (Print Job Managing Device, Fig. 3, col. 2, lines 10-50) to be executed by the print request from said client; and

(3) control means for transmitting print data (Print Data Sending Device, Fig. 3, col. 2, lines 10-50) of the print job in the print order from said image storage means to said printer if the print data is not transmitted from said client to said printer.

3.   Regarding claims 3 & 6, Kurachi further discloses a server apparatus, further comprising history storage means for (Print Data Storing Device, Fig. 3), at each print output by said printer, storing information indicative (print job information, col. 2, lines 44-50) of a client request the print output and a device transmitted (Print Job Sending Device, Fig. 3, col. 2, lines 21-23) print data to said printer.

4.   Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Kurachi (U.S. Pat.

6181436). Kurachi discloses a storage medium (RAM, Fig. 8A) storing a program (program

storage device, col. 21, line 23) realizing a print managing method for a server apparatus (print

server apparatus, col. 11, line 67, Fig. 6, ref #8) capable of communicating with at least one

client and a printer via a network (Fig. 1, col. 1, lines 5-9), said program realizing:

> (1) image storage process for storing print data (Print Data Storing Device, Fig. 3, col. 2,
>
> lines 10-50) of a print job to be executed by a print request from said client, into storage
>
> means (RAM, Fig. 8A).
>
> (2) order management process for managing a print order of the print job (Print Job
>
> Managing Device, Fig. 3, col. 2, lines 10-50) to be executed by the print request from
>
> said client; and
>
> (3) control process for transmitting print data (Print Data Sending Device, Fig. 3, col. 2,
>
> lines 10-50) of the print job in the print order from said image storage means to said
>
> printer if the print data is not transmitted from said client to said printer.

5.   Claims 8-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurachi (U.S.

Pat. 6181436).

6.   Regarding claims 8 & 11, Kurachi discloses an information processing apparatus

(personal computer, col. 12, lines 33-39) as a client (Fig. 1) capable of communicating with a

server apparatus which manages a print order and a printer via a network (Fig. 1), comprising:

(1) image storage means (Print Data Storing Device, Fig. 3, col. 2, lines 34-35) for storing print data of a print job to be executed by a print request;

(2) selection means (selection device, col. 8, line 63 and keyboard, col. 7, line 40) for causing a user to select a spool function (col. 1, lines 17-25) of said image storage means or that of said server apparatus for storing print data of a print job to be executed by a print request to said server apparatus; and

(3) control means (Print Job Managing Device, Fig. 3, col. 2, lines 10-25) for, if it is determined by using said selection means to use the spool function (col. 1, lines 17-25) of said server apparatus, transmitting (Print Data Sending Device, Fig. 3) said print data to said server apparatus, while if it is determined by using said selection means to use the spool function of said image storage means, controlling (controls by CPU, col. 7, line 31) said image storage means to store said print data.

7.   Regarding claims 9 & 12, Kurachi further discloses an information processing apparatus as a client capable of communicating with a server apparatus which manages a print order and a printer via a network further comprising notification means (network communication, col. 8, lines 1-5) for notifying said server apparatus of said selected spool function.

8.   Regarding claims 10 & 13, Kurachi further discloses an information processing apparatus as a client capable of communicating with a server apparatus which manages a print order and a printer via a network, wherein said selection means causes the user to make a selection by displaying a user interface screen image (Fig. 5, col. 3, lines 24-38).

9.   Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Kurachi (U.S. Pat.

6181436). Kurachi discloses a storage medium (RAM, col. 7, line 49-50) storing program (col.

7, line 44) for realizing a print managing method for an information processing apparatus

(personal computer, col. 12, lines 33-39) as a client capable of communicating with a server

apparatus which manages a print order and a printer via a network (Fig. 1), said program

realizing:

      (1) image storage process for storing print data (Print Data Storing Device, Fig. 3, col. 2,

lines 10-50) of a print job to be executed by a print request from said client, into storage

means (RAM, Fig. 8A).

      (2) selection process (selection device, col. 8, line 63 and keyboard, col. 7, line 40) for

causing a user to select a spool function (col. 1, lines 17-25) of said image storage means

or that of said server apparatus for storing print data of a print job to be executed by a

print request to said server apparatus; and

      (3) control process (Print Job Managing Device, Fig. 3, col. 2, lines 10-25) for, if it is

determined by using said selection means to use the spool function (col. 1, lines 17-25) of

said server apparatus, transmitting (Print Data Sending Device, Fig. 3) said print data to

said server apparatus, while if it is determined by using said selection means to use the

spool function of said image storage means, controlling (controls by CPU, col. 7, line 31)

said image storage means to store said print data.

10.   Claims 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurachi (U.S.

Pat. 6181436).

11.   Regarding claims 15 & 18, Kurachi discloses an information processing apparatus

(personal computer, col. 12, lines 33-39) as a client capable of communication a server apparatus

which manages a print order and a printer via a network (Fig. 1), comprising:

    (1) image storage means (Print Data Storing Device, Fig. 3, col. 2, lines 10-50) for

    storing print data of a print job to be executed by a print request;

    (2) determination means (determining device, col. 14, line 20) for determining one of a

    spool function (col. 1, lines 17-25) of said image storage means and that of said server

    apparatus for storing print data of a print job to be executed by a print request to said

    server apparatus; and

    (3) control means (Print Job Managing Device, Fig. 3, col. 2, lines 10-25), if said

    determination means determines to use the spool function of said server apparatus,

    transmitting (Print Data Sending Device, Fig. 3) said print data to said server apparatus,

    while said determination means determines to use the spool function of said image

    storage means, controlling (controls by CPU, col. 7, line 31) said image storage means to

    store said print data.

12.   Regarding claims 16 & 19, Kurachi further discloses an information processing apparatus

as a client capable of communication a server apparatus which manages a print order and a

printer via a network, further comprising notification means (network communication, col. 8, lines 1-5) for notifying said server apparatus of said selected spool function.

13.   Regarding claims 17 & 20, Kurachi further discloses an information processing apparatus as a client capable of communication a server apparatus which manages a print order and a printer via a network, wherein said determination means makes a determination by determining whether or not a remaining capacity of said image storage means is equal to or less than a predetermine amount of capacity (a capacity of the rough image storing device is smaller than a capacity of the output image data storing device, col. 26, lines 46-50).

14.   Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Kurachi (U.S. Pat. 6181436). Kurachi discloses a storage medium (RAM, col. 7, line 49-50) storing program (col. 7, line 44) for realizing a print managing method for an information processing apparatus (personal computer, col. 12, lines 33-39) as a client capable of communicating with a server apparatus which manages a print order and a printer via a network (Fig. 1), said program realizing:

(1) image storage process (Print Data Storing Device, Fig. 3, col. 2, lines 10-50) for storing print data of a print job to be executed by a print request;

(2) determination process (determining device, col. 14, line 20) for determining one of a spool function (col. 1, lines 17-25) of said image storage means and that of said server apparatus for storing print data of a print job to be executed by a print request to said server apparatus; and

(3) control process (Print Job Managing Device, Fig. 3, col. 2, lines 10-25) for, if it is determined at said determination process that the spool function of said server apparatus to be used, transmitting (Print Data Sending Device, Fig. 3) said print data to said server apparatus, while if it is determined at said determination process that the spool function of said image storage means to be used, controlling (controls by CPU, col. 7, line 31) said image storage means to store said print data.

15.   Claims 22-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurachi (U.S. Pat. 6181436).

16.   Regarding claims 22 & 26, Kurachi discloses an information processing apparatus (personal computer, col. 12, lines 33-39) as a client capable of communication a server apparatus which manages a print order and a printer via a network (Fig. 1), comprising:

(1) image storage means (Print Data Storing Device, Fig. 3, col. 2, lines 10-50) for storing print data of a print job to be executed by a print request;

(2) list acquisition means for acquiring a list of print jobs (Fig. 5) managed by said server apparatus;

(3) job designation means for, if image data of the print job designated by said designation means is stored in said image storage means, reading the image data from said image storage means (Print Job Receiving Device, Fig. 3 and Fig. 4), while if the image data is stored in said server apparatus, downloading the image data from said sever

apparatus (a print job information receiving device for receiving the print job information

from the printing apparatus, col. 2, lines 25-27 and Fig. 4); and

(4) control means for displaying a preview image based on the image data acquired by

said image acquisition means (In each of the client apparatuses, the list in which the

management information of the plurality of the print jobs and the plurality of the rough

images corresponding to the print jobs is displayed. When the user views this list, the

user can easily identify the print jobs by the rough images, and select the print jobs easily

and correctly, col. 3, lines 24-37 and Fig. 5)

17.   Regarding claims 23 & 27, Kurachi further discloses an information processing apparatus

as a client capable of communication a server apparatus which manages a print order and a

printer via a network, wherein said job designation means causes a user to perform designation

by displaying a user interface screen image (Fig. 12, col. 3, lines 24-37).

18.   Regarding claims 24 & 28, Kurachi discloses an information processing apparatus as a

client capable of communication a server apparatus which manages a print order and a printer via

a network, wherein said image data is an EMF file (converting device is a device for converting

the print data into picture data, such as bitmap data, col. 9, lines 38-46) comprising intermediate

data.

19.   Regarding claims 25 & 29, Kurachi discloses an information processing apparatus as a

client capable of communication a server apparatus which manages a print order and a printer via

a network, wherein said control means displays the preview image (Fig. 5) by controlling

drawing means (the rough image is produced by reducing the size of the image corresponding to

the print data or by simplify the image corresponding to the print data, col. 2, lines 51-67) of an

Operating System (application program, col. 7, lines 58-63) to execute the acquired EMF file.

20.   Claim 30 is rejected under 35 U.S.C. 102(e) as being anticipated by Kurachi (U.S. Pat.

6181436). Kurachi discloses a storage medium (RAM, col. 7, line 49-50) storing program (col. 7,

line 44) for realizing a print managing method for an information processing apparatus (personal

computer, col. 12, lines 33-39) as a client capable of communicating with a server apparatus

which manages a print order and a printer via a network (Fig. 1), said program realizing:

(1) image storage process (Print Data Storing Device, Fig. 3, col. 2, lines 10-50) for

storing print data of a print job, to be executed by a print request, into image storage

means;

(2) list acquisition process for acquiring a list of print jobs (Fig. 5) managed by said

server apparatus;

(3) job designation means for designating a print job to be previewed based on the list of

print jobs (Fig. 5) acquired by said acquisition means;

(4) image acquisition process for, if image data of the print job designated at said

designation process is stored in said image storage means, reading the image data from

said image storage means (Print Job Receiving Device, Fig. 3 and Fig. 4), while if the

image data is stored in said server apparatus, downloading the image data from said

server apparatus (a print job information receiving device for receiving the print job

information from the printing apparatus, col. 2, lines 25-27 and Fig. 4); and

(5) control process for displaying a preview image based on the image data acquired by

said image acquisition means (In each of the client apparatuses, the list in which the

management information of the plurality of the print jobs and the plurality of the rough

images corresponding to the print jobs is displayed. When the user views this list, the

user can easily identify the print jobs by the rough images, and select the print jobs easily

and correctly, col. 3, lines 24-37 and Fig. 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

21.   Claims 2 & 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi as

applied to claim 1 above, and further in view of Kuwamoto et al (U.S. Pat. 5617518).

22.   Regarding claims 2 & 5, Kurachi's server apparatus does not further include a

transmission means for, if the print data of the print job to be executed by the print request from

said client cannot be stored into said image storage means, causing said order management

means to manage the print order of the print job without storing the print data of the print job

into said image storage means, and transmitting a transmission permission to said client, in its

turn to perform printing, to transmit the print data to said printer.

Kuwamoto, in the same field of endeavor for printing server apparatus (Fig. 10),

discloses a transmission means for, if the print data (col. 2, line 35) of the print job to be

executed by the print request from said client (col. 2, line 64) cannot be stored into said image

storage means, causing said order management means (print program management, Fig. 10) to

manage the print order of the print job without storing the print data of the print job into said

image storage means (output data is supplied to the printing apparatus without being stored into

the memory device, col. 5, lines 12-23, and Abstract), and transmitting a transmission permission

to said client, in its turn to perform printing, to transmit (co. 4, lines 16-19) the print data to said

printer.

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to modify Kurachi's print server apparatus as per teachings of Kuwamoto because of a

following reason: (1) to reduce the waiting time of the print job (Kuwamoto, col. 3, lines 34-36);

thereby, improving print server's operating efficiency and to reduce operating cost.

Therefore, it would have been obvious to combine Kuwamoto with Kurachi to obtain the

invention as specified in claim 2.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents/publications are relevant to applicant's disclosure invention.

U.S. Patent No. 6292267 to Mori et al

U.S. Patent No. 6301016 to Matsueda et al.

U.S. Patent No. 6307640 to Montegi.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The

examiner can normally be reached on M-F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703)305-3900.

Thierry L. Pham

October 13, 2003

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